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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,353	02/27/2002	Ken Yoshioka	503.38156VX1	1842

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EXAMINER

MOORE, KARLA A

ART UNIT	PAPER NUMBER
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1763

DATE MAILED: 03/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

10/083,353

Applicant(s)

YOSHIOKA ET AL.

Examiner

Karla Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The claims include a processing apparatus and a method of using the apparatus and are therefore ambiguous. Examiner is unclear on what Applicant sees as the invention.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
5. The claimed invention is directed to non-statutory subject matter. The claims are directed to neither a "process" nor a "machine", but rather embrace and overlap two different statutory classes of invention set forth in 35 U.S.C. 101, which is drafted to set forth the statutory classes of invention in the alternative only.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,769,952 to Komino.

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8. Komino discloses an apparatus for processing a specimen, comprising: an etching process unit (Figure 1, 10A-C; column 5, rows 48-59), which is supplied with a gas to produce plasma (column 12, rows 9-12); a rinsing unit (18A and 18C; column 6, rows 7-10); and a dryer unit (18B and 18D; column 5, rows 48-59) for drying.

9. With respect to the limitations of claim 1 drawn to an intended method to be performed using the apparatus, the courts have ruled that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex Parte Masham*, 2, USPQ 2d 1647 (Bd. Pat. App. & Inter. 1987).

10. With respect to the limitations of claim 1 drawn to the article to be worked upon, the courts have ruled that the inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. *In re Young*, 75 F. 2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F. 2d 937, 136 USPQ 458, 459 (CCPA 1963)).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

~~12. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komino as~~

applied to claim 1 above, and further in view of U.S. Patent No. 5,303,671 to Kondo et al. and Japanese Patent No. 60-183996 to Kameyama.

13. Komino discloses the invention substantially as claimed and as described above.

14. Additionally, Komino discloses: an atmospheric loader (20); a vacuum transport chamber (14) having a vacuum transport robot (16) therein; and unload and loadlock chambers (130A and 130B) connecting between said atmospheric loader and said vacuum transport chamber for delivering the

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specimen via an atmospheric transport unit (22), wherein said vacuum transport chamber is connected to all of the etching process chambers of said etching process unit, and said atmospheric loader is connected via said atmospheric transport unit to said rinsing unit and drying unit.

15. With respect to claim 3, Komino teaches that any number of the three processing chambers, 10A-C, may be etching chambers (column 5, rows 48-59).

16. However, Komino fails to teach a rinsing cup in the rinsing unit and a hot plate in the drying unit.

17. Kondo et al. Teach the use of a hot plate for the purpose of heating/drying a specimen after washing (column 8, rows 28-30).

18. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided a hot plate in the drying unit of Komino in order to heat/dry a specimen after washing as taught by Kondo et al.

19. Kameyama teaches the use of a rinsing cup for the purpose of reducing the adhesion of dust, to use only a small amount of treating liquid and to equalize the extent of a treatment (purpose and constitution).

20. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided a rinsing cup in the rinsing unit of Komino in order to reduce adhesion of dust, use only a small amount of treating liquid and to equalize the extent of treatment as taught by Kameyama.

### ***Response to Arguments***

21. In response to applicant's argument that Komino fails to teach the processing apparatus as "dedicated for processing a specimen having a plurality of layers at least one of which includes NiFe or NiFeCo alloy" and "designed to permit etching of the specimen under a low specimen temperature", a recitation of the intended use of the claimed invention and article to be worked upon must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a

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manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In *re Young*, 75 F. 2d 966, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F. 2d 937, 136 USPQ 458, 459 (CCPA 1963)).

22. With respect to Applicant's argument that the rinse and dry units of Komino are not arranged in a unitary apparatus, Examiner disagrees with this characterization of the reference as all of the processing parts are connected to form one unitary apparatus. Additionally, Examiner points out that this limitation is not structurally present in the claims as currently recited.

### **Conclusion**

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karla Moore whose telephone number is 703.305.3142. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on 703.308.1633. The fax phone numbers for the organization where this application or proceeding is assigned are 703.872.9310 for regular communications and 703.872.9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

km

March 28, 2003



BENJAMIN L. UTECH  
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